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HEWLETT-PACKARD COMPANY		DALENCOL	JRT, YVES	
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Fort Collins, CO 80527-2400			2157	

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Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)			
	10/056,687	SIMPSON ET AL.			
Office Action Summary	Examiner	Art Unit			
·	Yves Dalencourt	2157			
The MAILING DATE of this communication app Period for Reply	The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply				
A SHORTENED STATUTORY PERIOD FOR REPL' THE MAILING DATE OF THIS COMMUNICATION.  - Extensions of time may be available under the provisions of 37 CFR 1.1 after SIX (6) MONTHS from the mailing date of this communication.  - If the period for reply specified above is less than thirty (30) days, a reply - If NO period for reply is specified above, the maximum statutory period of Failure to reply within the set or extended period for reply will, by statute Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	36(a). In no event, however, may a reply be t y within the statutory minimum of thirty (30) da vill apply and will expire SIX (6) MONTHS fro , cause the application to become ABANDON	timely filed  ays will be considered timely.  m the mailing date of this communication.  IED (35 U.S.C. § 133).			
Status					
1) Responsive to communication(s) filed on 24 Ja	anuary 2002.				
	action is non-final.				
3) Since this application is in condition for allowar		rosecution as to the merits is			
closed in accordance with the practice under E					
Disposition of Claims	•	· v			
4) Claim(s) 1-35 is/are pending in the application.					
4a) Of the above claim(s) is/are withdraw					
5) Claim(s) is/are allowed.					
6)⊠ Claim(s) <u>1-35</u> is/are rejected.	<u> </u>				
7) Claim(s) is/are objected to.					
8) Claim(s) are subject to restriction and/o	r election requirement.				
Application Papers					
9) The specification is objected to by the Examine	rr.				
10)⊠ The drawing(s) filed on 24 January 2002 is/are.		ed to by the Examiner.			
Applicant may not request that any objection to the					
Replacement drawing sheet(s) including the correct		• •			
11) The oath or declaration is objected to by the Ex					
Priority under 35 U.S.C. § 119					
12) Acknowledgment is made of a claim for foreign	priority under 35 U.S.C. § 1196	a)-(d) or (f).			
a) ☐ All b) ☐ Some * c) ☐ None of:					
1. Certified copies of the priority document	s have been received.	-			
2. Certified copies of the priority document		ition No.			
3. Copies of the certified copies of the priority documents have been received in this National Stage					
application from the International Bureau		3			
* See the attached detailed Office action for a list	of the certified copies not receiv	ved.			
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Attachment(s)					
1) Notice of References Cited (PTO-892)	4) Interview Summar				
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)	Paper No(s)/Mail [ 5) Notice of Informal	Date Patent Application (PTO-152)			
Paper No(s)/Mail Date <u>01/24/02</u> .	6) Other:	. a.o.n. ryphoddolf (1 10-102)			
U.S. Patent and Trademark Office PTOL-326 (Rev. 1-04)  Office Ac	tion Summary F	Part of Paper No./Mail Date 20050328			

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### **DETAILED ACTION**

This office action is responsive to communication filed on 01/24/2002.

## Claim Objections

Claim 2 is objected to because of the following informalities: It is suggested to delete " a " before generic access.

Appropriate correction is required.

#### **Double Patenting**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 – 35 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 –2, 7 – 25, and 30 - 46 of copending Application No. 10/159,199. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons. See tables below.

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Instant Application 10/056-687	Co-pending Application 10/159-199
Claim 1: A method for accessing data comprising:	Claim 1: A method for accessing data comprising:
configuring data at least partially obtained from an enterprise resource planning system;	configuring data at least partially obtained from a mainframe system;
storing said data; and	storing said data; and
identifying said data to be accessed in response to a generic access instruction.	identifying said data to be accessed in response to at least one generic access instruction.

Table 1

As shown in the above table 1, the only difference between the claims is the instant application recites an "enterprise resource planning", while the co-pending application recites a "mainframe" and the two terms are interchangeably used in the art.

The operation of "configuring data at least partially obtained" is the same in each of the above applications.

Thus, the limitation of configuring data is not affected by the source of that data, whether from "an enterprise resource planning system or a mainframe system " (see specification of the instant application 10/056,687; paragraphs [0057], [0059], and [0060]; and co-pending application 10/159,199; paragraphs [0059] and [0060].

Applicant is reminded "A limitation on a claim can broadly be thought of then as its ability to make a meaningful contribution to the definition of the invention in a claim. In other words, language that is not functionally interrelated

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with the useful acts, structure, or properties of the claimed invention will not serve as a limitation ". See In re Gulack, 217 USPQ 401 (CAFC 1983).

In accordance with **In re Gulack,** the source of the data does not affect the scope of the claim because it is not functionally interrelated with the "configuring data at least partially obtained" acts.

Instant Application 10/056-687	Co-pending Application 10/159-199
Claim 8: A method for outputting data comprising:	Claim 12: A method for outputting data comprising:
providing a client having capability to execute a web browser, providing an extension;	providing a client having capability to execute a web browser, providing an extension;
configuring data partially obtained from an enterprise resource planning system;	configuring data partially obtained from a configuring data partially obtained from mainframe system
identifying said data to be accessed in response to a generic access instruction;	identifying said data to be accessed in response to at least one generic access instruction;
communicating a first web content to said client containing a generic access instruction causing a portion of said data to be accessed;	communicating a first web content to said client containing a generic access instruction causing a portion of said data to be accessed;
communicating a second web content to said client providing capability for outputting said data;	communicating a second web content to said client providing capability for outputting said data;
and outputting said data.	and outputting said data.

Table 2

As shown in the above table 2, the only difference between the claims is the instant application recites an "enterprise resource planning", while the co-pending

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application recites a " mainframe " and the two terms are interchangeably used in the art.

The operation of "configuring data at least partially obtained" is the same in each of the above applications.

Thus, the limitation of configuring data is not affected by the source of that data, whether from "an enterprise resource planning system or a mainframe system " (see specification of the instant application 10/056,687; paragraphs [0057], [0059], and [0060]; and co-pending application 10/159,199; paragraphs [0059] and [0060].

Applicant is reminded "A limitation on a claim can broadly be thought of then as its ability to make a meaningful contribution to the definition of the invention in a claim. In other words, language that is not functionally interrelated with the useful acts, structure, or properties of the claimed invention will not serve as a limitation ". See In re Gulack, 217 USPQ 401 (CAFC 1983).

In accordance with **In re Gulack**, the source of the data does not affect the scope of the claim because it is not functionally interrelated with the "configuring data at least partially obtained" acts.

Instant Application 10/056-687	Co-pending Application 10/159-199
Claim 19: A system for accessing data comprising:	Claim 23: A system for accessing data comprising:
apparatus for obtaining data from an enterprise resource planning ("ERP") system;	data at least partially obtained from a mainframe system;
apparatus for implementing a generic access instruction;	at least one generic access instruction;

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and an extension configured to respond to said at least one generic access instruction.

Table 3

As shown in the above table 3, the only difference between the claims is the instant application recites an "enterprise resource planning", while the co-pending application recites a "mainframe" and the two terms are interchangeably used in the art.

The operation of "configuring data at least partially obtained" is the same in each of the above applications.

Thus, the limitation of configuring data is not affected by the source of that data, whether from "an enterprise resource planning system or a mainframe system " (see specification of the instant application 10/056,687; paragraphs [0057], [0059], and [0060]; and co-pending application 10/159,199; paragraphs [0059] and [0060].

Applicant is reminded "A limitation on a claim can broadly be thought of then as its ability to make a meaningful contribution to the definition of the invention in a claim. In other words, language that is not functionally interrelated with the useful acts, structure, or properties of the claimed invention will not serve as a limitation ". See In re Gulack, 217 USPQ 401 (CAFC 1983).

In accordance with **In re Gulack**, the source of the data does not affect the scope of the claim because it is not functionally interrelated with the "configuring data at least partially obtained" acts.

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Instant Application 10/056-687	Co-pending Application 10/159-199
Claim 26: A system for sharing data comprising:	Claim 36: A system for sharing data comprising:
apparatus for partially obtaining data from an enterprise resource planning system;	a client; data at least partially obtained from a mainframe system;
an extension configured to respond to a generic access instruction for communicating with web content containing a generic access instruction;	an extension configured to respond to at least one generic access instruction for communicating with web content containing a generic access instruction;
and an output device.	and an output device.

Table IV

As shown in the above table IV, the only difference between the claims is the instant application recites an "enterprise resource planning", while the co-pending application recites a "mainframe" and the two terms are interchangeably used in the art.

The operation of "configuring data at least partially obtained" is the same in each of the above applications.

Thus, the limitation of configuring data is not affected by the source of that data, whether from "an enterprise resource planning system or a mainframe system " (see specification of the instant application 10/056,687; paragraphs [0057], [0059], and [0060); and co-pending application 10/159,199; paragraphs [0059] and [0060].

Applicant is reminded "A limitation on a claim can broadly be thought of then as its ability to make a meaningful contribution to the definition of the invention in a claim. In other words, language that is not functionally interrelated

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with the useful acts, structure, or properties of the claimed invention will not serve as a limitation ". See In re Gulack, 217 USPQ 401 (CAFC 1983).

In accordance with **In re Gulack**, the source of the data does not affect the scope of the claim because it is not functionally interrelated with the "configuring data at least partially obtained" acts.

Claims 2 - 7, 9 - 18, 20 - 25, and 27 - 35 of the Instant Application No. 10/056,687 are the same as claims 2, 7 - 11, 13 - 22, 24 - 25, 31 - 35, and 37 - 46 of copending Application No. 10/159,199.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

## Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 – 7 and 19 - 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Grasso et al (US 2002/0116291; hereinafter Grasso).

Regarding claim 1, Grasso teaches a method for accessing data (200, fig. 3), comprising the steps of configuring data at least partially obtained from an enterprise resource planning system (210, fig. 3; paragraph [0057]; [0058], lines 1-3; and [0062], lines 1-4; Grasso discloses a distributed knowledge management service provider, wherein said service provider is an enterprise resource planning uses to extract content from captured documents and indexed); storing said data (paragraphs [0058], lines 3-8; [0062], lines 7-13; Grasso discloses that the service provider 210 records the document 120 in the digital archive it host for the user 50); and identifying said data to be accessed in response to a generic access instruction (paragraph [0058], lines 8-12; [0059]; and [0064]; Grasso discloses that the service provider 210 then transmits the print job to the user's printer 112 where the printed document is produced).

Regarding claim 2, Grasso teaches the method of claim 1, which further comprising the step of receiving said a generic access instruction (paragraph [0064], lines 1 - 3); and accessing said data (paragraph [0064], lines 3 - 13).

Regarding claim 3, Grasso teaches the method of claim 1, wherein said storing said data comprises storing a portion of said data in an independent image format (paragraph [0020]).

Regarding claim 4, Grasso teaches the method of claim 1, which further comprises the step of generating a generic access request in response to said generic access instruction (paragraphs [0027] and [0032]; Grasso discloses that a recommendation may be generated based on a determination of document-document

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similarity (similarity of the requested document to other documents in the recommender system).

Regarding claim 5, Grasso teaches the method of claim 1, wherein said identifying comprises associating said data with a computer user (paragraphs [0028] and [0042]).

Regarding claim 6, Grasso teaches the method of claim 1, wherein said identifying comprises utilizing server side technology (paragraphs [0061] and [0064]).

Regarding claim 7, Grasso teaches the method of claim 1, wherein said identifying comprises utilizing client side technology (paragraphs [0061] and [0064]).

Regarding claim 19, Grasso teaches a system for accessing data comprising: apparatus for obtaining data from an enterprise resource planning ("ERP") system (210, fig. 3; paragraph [0057]; [0058], lines 1-3; and [0062], lines 1-4; Grasso discloses a distributed knowledge management service provider, wherein said service provider is an enterprise resource planning uses to extract textual content from captured documents and indexed); apparatus for implementing a generic access instruction (paragraph 0033); and an extension configured to respond to said generic access instruction (paragraph [0058], lines 8-12; [0059]; and [0064]; Grasso discloses that the service provider 210 then transmits the print job to the user's printer 112 where the printed document is produced).

Regarding claim 20, Grasso teaches the system of claim 19, wherein said generic access instruction causes said extension to access said data (paragraph [0058], lines 8 – 12; [0059]; and [0064]).

Regarding claim 21, Grasso teaches the system of claim 19, wherein said data represents an image having an independent format (paragraph [0020]).

Regarding claim 22, Grasso teaches the system of claim 19, wherein said generic access instruction causes a generic access request (paragraphs [0027] and [0032]; Grasso discloses that a recommendation may be generated based on a determination of document-document similarity (similarity of the requested document to other documents in the recommender system).

Regarding claim 23, Grasso teaches the system of claim 19, wherein said apparatus for implementing a generic access instruction includes communicating using the Internet (paragraphs [0028] and [0033]).

Regarding claim 24, Grasso teaches the system of claim 19, wherein said generic access instruction includes instruction communicated in hypertext transfer protocol (paragraph [0061], lines 9 - 14).

Regarding claim 25, Grasso teaches the system of claim 22, wherein said generic access request includes requests communicated by way of the Internet (paragraph [0063])

Regarding claim 26, Grasso teaches a system for sharing data comprising: apparatus for partially obtaining data from an enterprise resource planning system (210, fig. 3; paragraph [0057]; [0058], lines 1 – 3; and [0062], lines 1 – 4; Grasso discloses a distributed knowledge management service provider, wherein said service provider is an enterprise resource planning uses to extract textual content from captured documents and indexed); an extension configured to respond to a generic access

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instruction for communicating with web content containing a generic access instruction (paragraph [0058], lines 8 – 12; [0059]; and [0064]; Grasso discloses that the service provider 210 then transmits the print job to the user's printer 112 where the printed document is produced); and an output device (paragraph [0028]).

Regarding claim 27, Grasso teaches the system of claim 26, wherein said generic access instruction causes said extension to access said data (paragraph [0058], lines 8 – 12; [0059]; and [0064]).

Regarding claim 28, Grasso teaches the system of claim 26, wherein said data from an enterprise resource planning system includes an image having an independent format (paragraph [0020]).

Regarding claim 29, Grasso teaches the system of claim 26, wherein said extension causes said data to be output using said output device (paragraph [0028]).

Regarding claim 30, Grasso teaches the system of claim 29, wherein said data output includes data output using the Internet (paragraph [0063]).

Regarding claim 31, Grasso teaches the system of claim 26, wherein said extension includes executing a browser (paragraph [0034]).

Regarding claim 32, Grasso teaches the system of claim 26, wherein said extension includes the characteristics of said client (paragraph [0058], lines 8 – 12; [0059]; and [0064]; Grasso discloses that the service provider 210 then transmits the print job to the user's printer 112 where the printed document is produced).

Regarding claim 33, Grasso teaches the system of claim 26, wherein said data is associated with a user of said client (paragraphs [0028] and [0042]).

Regarding claim 34, Grasso teaches the system of claim 33, wherein said data is associated with said user using client side apparatus (paragraphs [0061] and [0064]).

Regarding claim 35, Grasso teaches the system of claim 33, wherein said data is associated with said user using server side apparatus (paragraphs [0061] and [0064]).

## Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 8 - 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grasso et al (US 2002/0116291; hereinafter Grasso) in view of John Croy (US 2001/0047384 A1; hereinafter Croy).

Regarding claim 8, Grasso teaches a method for outputting data () 10, fig. 1) comprising the steps of providing a client having capability to execute a web browser (paragraphs [0022]; [0031]; Grasso discloses that the recommender system may create a map of what has been printed in a work group. This information can then be browsed or searched from an electronic interface 60 to the system 100), providing an extension (paragraph [0031]); configuring data partially obtained from an enterprise resource planning system (210, fig. 3; paragraph [0057]; [0058], lines 1 - 3; and [0062], lines 1 -4; Grasso discloses a distributed knowledge management service provider, wherein said service provider is an enterprise resource planning uses to extract textual content from captured documents and indexed); identifying said data to be accessed in response to a generic access instruction (paragraph [0058], lines 8 – 12; [0059]; and [0064]; Grasso discloses that the service provider 210 then transmits the print job to the user's printer 112 where the printed document is produced); communicating a first web content to said client containing a generic access instruction causing a portion of said data to be accessed (paragraph [0064]; Grasso discloses that the service provider may provide an XML interface through which document content and user requests can be passed between the user interface and the server).

Grasso teaches substantially all the limitations, except for the use of communicating a second web content to said client providing capability for outputting said data; and outputting said data.

However, Croy teaches an analogous method and system for providing personalized content over a network, which comprises the steps of communicating a

second web content to said client providing capability for outputting said data (103, fig. 1; paragraphs [0041], [0091], and [0092], lines 1 – 15. In particular Croy discloses the second server may provide computer code or machine commands to client (109) instructing the client to carry out certain actions or enabling the user (107) to perform certain actions on the client); and outputting said data (paragraphs [0041] and [0079]; Croy discloses that the second server may supply graphical or audio content which is presented to the user by the client).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Grasso's by communicating a second web content to said client providing capability for outputting said data; and outputting said data as evidenced by Croy. One of ordinary skill in the art would have found it motivated to utilize such a modification in order to provide Grasso's system the enhanced capability of allowing a server to provide a set of instructions which can be used to generate audio on the user client, thereby saving processing resources, transmission time, and memory.

Regarding claim 9, Grasso and Croy teach all the limitations in claim 8, and Grasso further teaches that said identifying comprises associating said data with a computer user (paragraphs [0028] and [0042].

Regarding claim 10, Grasso and Croy teach all the limitations in claim 8, and Grasso further teaches that said identifying comprises utilizing client side technology (paragraphs [0061] and [0064]).

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Regarding claim 11, Grasso and Croy teach all the limitations in claim 8, and Grasso further teaches that said identifying comprises utilizing server side technology (paragraphs [0061] and [0064]).

Regarding claim 12, Grasso and Croy teach all the limitations in claim 8, and Grasso further comprises tailoring said extension to characteristics of said client (paragraph [0064]; Grasso discloses that the service provider may provide an XML interface through which document content and user requests can be passed between the user interface and the server. Using an XML interface offers several advantages in that a number of user interfaces are available which would be tailored in order to communicate with the service provider).

Regarding claim 13, Grasso and Croy teach all the limitations in claim 8, and Croy further teaches that said outputting said data includes outputting additional data (paragraph [0092], lines 15 – 18; Croy discloses that the data output can also be a smaller file enabling faster download and less waiting because it may be only a component of the total audio).

One of ordinary skill in the art would have been motivated to utilize such a modification in order to further enhanced the system and method of Grasso by allowing a server to provide a set of instructions which can be used to output additional data on the user client, thereby saving processing resources, transmission time, and memory.

Regarding claim 14, Grasso and Croy teach all the limitations in claim 8, and Croy further teaches that said outputting said data includes outputting to multiple devices (paragraph [0091]).

One of ordinary skill in the art would have been motivated to utilize such a modification in order to further enhanced the system and method of Grasso by allowing a server to provide a set of instructions which can be used to output additional data to multiple devices, thereby saving processing resources, transmission time, and memory.

Regarding claim 15, Grasso and Croy teach all the limitations in claim 8, and Grasso further teaches that said generic access instruction causes a portion of said data to be accessed causes additional data to be accessed (paragraph [0057]; Grasso discloses that in addition to capturing to providing recommender services to users of recording devices, other document related services may also be provided).

Regarding claim 16, Grasso and Croy teach all the limitations in claim 8, and Grasso further teaches that a portion of said communicating said first web content utilizes a firewall (paragraphs [0061] and [0063]).

Regarding claim 17, Grasso and Croy teach all the limitations in claim 8, and Grasso further teaches that a portion of said communicating said first web content utilizes the Internet (paragraph [0063]).

Regarding claim 18, Grasso and Croy teach all the limitations in claim 8, and Grasso further comprising storing a portion of said data in an independent image format (paragraph [0020]).

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#### **Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yves Dalencourt whose telephone number is (571) 272-3998. The examiner can normally be reached on M-TH 7:30AM - 6: 00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Yves Dalencourt

April 07, 2005